UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/209,162	12/10/1998	MICHELLE BAKER	BAK-004	9135

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EXAMINER
PAULA, CESAR B

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 11/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary		09/209,162	BAKER, MICHELLE
		Examiner	**Art Unit**
		CESAR B PAULA	2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>12 August 2002</u> .

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-24, 26 and 27</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-24, 26-27</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

1.   This action is responsive to the RCE, declaration and remarks under 37 CFR 1.131 filed

on 7/22/2002.

        This action is made Non-Final.

2.   Claims 1-24, and 26-27 are pending in the case. Claims 1, 13, 20, and 26-27 are

independent claims.

3.   The rejections of claims 1-2, 10-11, 20, and 22 under 35 U.S.C. 103(a) as being

unpatentable over Fleming, Internet Explorer 4 6-In-1 (pages 182-185, 201-205, 210-217, 265-

271, 11/3/97), in view of Mosher, Microsoft Outlook E-Mail & Fax Guide (12/1/97) have been

withdrawn as necessitated by the 37 CFR1.131 declaration.

4.   The rejections of claims 3-4, and 8-9, 12, 21, and 26 under 35 U.S.C. 103(a) as being

unpatentable over Fleming, Internet Explorer 4 6-In-1, in view of Mosher as applied to claim 1

above, and further in view of Wolf et al (Pat. # 5,818,447, 10/6/1998, filed on 6/6/1996) have

been withdrawn as necessitated by the 37 CFR1.131 declaration.

5.   The rejections of claims 13-14 under 35 U.S.C. 103(a) as being unpatentable over

Fleming, Internet Explorer 4 6-In-1, in view of Bradshaw et al, hereinafter Bradshaw (Pat. #

6,065,056, 5/16/00, filed on 8/13/98) have been withdrawn as necessitated by the 37 CFR1.131

declaration.

6.   The rejections of claims 15-16 under 35 U.S.C. 103(a) as being unpatentable over

Fleming, Internet Explorer 4 6-In-1, in view of Bradshaw et al, further in view of Wolf et al

have been withdrawn as necessitated by the 37 CFR1.131 declaration.

7.   The rejections of claims 5-7, and 23-24 under 35 U.S.C. 103(a) as being unpatentable

over Fleming, Internet Explorer 4 6-In-1, in view of Mosher as applied to claim 1 above, and

further in view of Hong et al (Pat. # 5,710,883, 1/20/1998, filed on 3/10/1995) have been

withdrawn as necessitated by the 37 CFR1.131 declaration.

8.   The rejections of claims 17-19 under 35 U.S.C. 103(a) as being unpatentable over

Fleming, Internet Explorer 4 6-In-1, in view of Bradshaw, and further in view of Hong et al have

been withdrawn as necessitated by the 37 CFR1.131 declaration.

9.   The rejections of claims 27 under 35 U.S.C. 102(e) as being anticipated by Dawson

(Pat.# 6,252,588 B1, 6/26/01, filed on 6/16/98) have been withdrawn as necessitated by the 37

CFR1.131 declaration.

Drawings

10.   This application has been filed with informal drawings which are acceptable for

examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 102

11.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United
States before the invention thereof by the applicant for patent, or on an international application by another who
has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention
thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) do not apply to the examination of this application as the application being examined

was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment

by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

12.   Claims 1-4, 8-11, 20-22, and 26-27 are rejected under 35 U.S.C. 102(e) as being

anticipated by Wolf et al, hereinafter Wolf (Pat. # 5,818,447, 10/6/1998, filed on 6/6/1996).

Regarding independent claim 1, Wolf discloses: a plurality of word processing

components for creating, editing, and encoding an internet-compatible email document (c.2, L.8-

67, c.9, L.1-c.10,L.67, and fig.3).

Furthermore, Wolf discloses the editing or decoding of the internet-compatible email

document (c.2, L.8-67, c.9, L.1-c.10,L.67, and fig.3).

Regarding claim 2, which depends on claim 1, Wolf discloses the editing of an email

document using a full featured word-processor, which as was well known in the art included

installable components, such as a spell checker (c.2, L.8-67, c.9, L.1-c.10,L.67, and fig.3).

Regarding claim 3, which depends on claim 1, Wolf discloses the editing of an email

document using a full featured word-processor, spreadsheet, desktop publishing applications, etc

(c.2, L.8-67, c.9, L.1-c.10,L.67, and c.23,L.59-67).

Regarding claim 4, which depends on claim 1, Wolf discloses the editing of an email

document using a full featured word-processor, spreadsheet, desktop publishing applications, etc

(Col. 14, lines 56-62), and "...the interfaces and techniques described herein may be applied to

incorporate other types of applications....spreadsheet program......" (Col. 23, lines 61-67).

Regarding claim 8, which depends on claim 1, Wolf discloses: "...the mail note allows a separate, full-featured word processing program to display and edit the message......" (Col. 14, lines 56-62), and "..allow a spreadsheet program....to display their respective documents in the view port provided by the container mail note......" (Col. 23, lines 64-67).

Claim 9 is directed towards a method for implementing the mail client found in claim 8, and is similarly rejected.

Regarding claim 10, which depends on claim 1, Wolf discloses an email authoring program which allowed a user to retrieve an email message or reply to an author or other users or readers (c.2,L.8-67, and c.5,L.20-67).

Regarding claim 11, which depends on claim 1, Wolf discloses an email authoring program which allowed a user to retrieve an email message or reply to an author or other users or readers (c.2,L.8-67, and c.5,L.20-67)--*at least one of said authoring components includes means for recognizing whether a user is an author or a reader.*

Regarding claim 21, which depends on claim 20, Wolf discloses: "...the mail note allows a separate, full-featured word processing program to display and edit the message......" (Col. 14, lines 56-62), and "..allow a spreadsheet program....to display their respective documents in the view port provided by the container mail note......" (Col. 23, lines 64-67). Wolf teaches an email authoring program to personalize email documents using an stationary graphics, and spellchecking components among other document-authoring components.

Furthermore, Wolf discloses "...the mail note allows a separate, full-featured word processing program to display and edit the message......" (Col. 14, lines 56-62) , and "...the interfaces and techniques described herein may be applied to incorporate other types of

applications....spreadsheet program......" (Col. 23, lines 61-67). *--linking each of said*

document-authoring components with the document-encoding component.

Regarding independent claim 26, Wolf discloses *a) a plurality of authoring components a*

first ...for creating a different kind of email message- b) encoding means for automatically

encoding said representations...into an Internet-compatible email message as outlined in claim 1

above.

Furthermore, Wolf discloses: "the email client determines which mail note should be

launched....determined by the selected message" (c. 2,L.8-67, c. 20, L.15-67).*-- c) decoding*

means for automatically decoding said representations .... Wolf teaches above the invocation of

the proper email note for reading and viewing the decoded internet-compatible email message.

Claim 20, 22, and 27 is directed towards a method for implementing the mail client

found in claims 1, 11, and (1 and 8) respectively, and therefore are similarly rejected.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

14. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolf.

Regarding claim 12, which depends on claim 1, Wolf discloses: "...the mail note allows a

separate, full-featured word processing program to display and edit the message......" (Col. 14,

lines 56-62) , and "...the interfaces and techniques described herein may be applied to

incorporate other types of applications....spreadsheet program......" (Col. 23, lines 61-67).

Wolf fails to explicitly disclose: *at least one of said authoring components includes means for*

allowing a user to create a read-only document. However, It would have been obvious to a

person of ordinary skill in the art at the time of the invention to have *created a read-only*

document as it was well known in the art at the time of the invention, because Wolf et al teach:

"..allow a spreadsheet program....to display their respective documents in the view port provided

by the container mail note......" (Col. 23, lines 64-67).

15.   Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolf, in

view of Bradshaw et al, hereinafter Bradshaw (Pat. # 6,065,056, 5/16/00, filed on 8/13/98).

        Regarding independent claim 13, Wolf discloses: *a) a plurality of authoring components*

a first .....creating a representation of a document including other than text --b) encoding means

for automatically encoding said representations... --c) decoding means for automatically

decoding said representations .... – in the rejections of claim 1 above.

        Furthermore, Wolf fails to explicitly disclose *at least one of said authoring components*

includes means for determining whether the user is a student or a teacher. Bradshaw teaches:

"enabling a supervisory adult to monitor incoming and outgoing E-mail" (col.3, lines 30-67, and

col.4, lines 16-67). It would have been obvious to a person of ordinary skill in the art at the time

of the invention to have combined the teachings of Wolf, and the monitoring of a student by a

teacher or supervisor through a password protected account as taught by Bradshaw, because

Bradshaw teaches above the monitoring, and blocking of offensive email messages by a

supervisor—*teacher.*

Claim 14 is directed towards an electronic mail client for implementing the mail client found in claim 2, and is similarly rejected.

Regarding claim 15, which depends on claim 13, However, Wolf et al disclose: "the mail note allows a separate, full-featured word processing program to display and edit the message" (Col. 14, lines 56-62), and "the interfaces and techniques described herein may be applied to incorporate other types of applications….spreadsheet program" (Col. 23, lines 61-67)-- *said plurality of authoring components include at least one… of ……workbook component, and a graphic component.* It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wolf, and Bradshaw, because Wolf et al teach above the implementation of full-featured application programs (word processors, spreadsheet, drawing etc.) for display and editing an e-mail message.

Regarding claim 16, which depends on claim 13, Wolf discloses: "the mail note allows a separate, full-featured word processing program to display and edit the message" (Col. 14, lines 56-62), and "the interfaces and techniques described herein may be applied to incorporate other types of applications….spreadsheet program" (Col. 23, lines 61-67)--*said plurality of authoring components include at least one… of ……database component, a presentation component.* It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wolf, and Bradshaw, because Wolf et al teach: "allow a spreadsheet program….to display their respective documents in the view port provided by the container mail note" (Col. 23, lines 64-67).

16.   Claims 5-7, and 23-24 remain rejected under 35 U.S.C. 103(a) as being unpatentable over

Wolf as applied to claim 1 above, and further in view of Hong et al (Pat. # 5,710,883, 1/20/1998,

filed on 3/10/1995).

Regarding claim 5, which depends on claim 1, Wolf discloses the editing or decoding of

the internet-compatible email document (c.2, L.8-67, c.9, L.1-c.10,L.67, and fig.3). Wolf fails to

explicitly disclose: .....*said encoding means includes MIME-compatible encoding means.*

However, Hong et al disclose: "...program then converts each new note into a formal HTML

document.....which encodes......MIME.......scheme is used......" (Col. 5, lines 2-11). It would

have been obvious to a person of ordinary skill in the art at the time of the invention to had

combined the teachings of Wolf and Hong et al, because Hong et al teach: ".....HTML

documents.....are then concatenated into a single e-mail message......" (Col. 5, lines 5-9).

Regarding claim 6, which depends on claim 1, Wolf discloses the editing or decoding of

the internet-compatible email document (c.2, L.8-67, c.9, L.1-c.10,L.67, and fig.3). Wolf fails to

explicitly disclose: *said encoding means includes means for creating a MIME-compatible file* .....

However, Hong et al disclose: "...program then converts each new note into a formal HTML

document.....which encodes......MIME.......scheme is used......" (Col. 5, lines 2-11). It would

have been obvious to a person of ordinary skill in the art at the time of the invention to had

combined the teachings of Wolf and Hong et al, because Hong et al teach: ".....HTML

documents.....are then concatenated into a single e-mail message......" (Col. 5, lines 5-9).

Furthermore, Wolf discloses the editing or decoding of the internet-compatible email

document (c.2, L.8-67, c.9, L.1-c.10,L.67, and fig.3). Wolf fails to explicitly disclose: *each of*

said authoring component cooperating with said encoding means such that a creation of said

MIME file......is transparent to the user. However, Hong et al disclose: "...program then

converts each new note into a formal HTML document.....which

encodes......MIME.......scheme is used......" (Col. 5, lines 2-11). It would have been obvious

to a person of ordinary skill in the art at the time of the invention to had combined the teachings

of Wolf and Hong et al *such that a creation of said MIME file.....is transparent to the user,*

because Hong et al teach: ".....HTML documents.....are then concatenated into a single e-mail

message......" (Col. 5, lines 5-9).

Regarding claim 7, which depends on claim 6, Wolf discloses the editing or decoding of

the internet-compatible email document (c.2, L.8-67, c.9, L.1-c.10,L.67, and fig.3). Wolf fails to

explicitly disclose: .....*said decoding means includes means for concatenating a multipart MIME*

message......... However, Hong et al disclose: ".....HTML documents.....are then concatenated

into a single e-mail message......" (Col. 5, lines 5-9). It would have been obvious to a person of

ordinary skill in the art at the time of the invention to have combined the teachings of Wolf and

Hong et al, because Hong et al teach: ".....HTML documents.....are then concatenated into a

single e-mail message......" (Col. 5, lines 5-9).

Furthermore, Wolf discloses the editing or decoding of the internet-compatible email

document (c.2, L.8-67, c.9, L.1-c.10,L.67, and fig.3). Wolf fails to explicitly disclose: *each of*

said authoring component cooperating with said decoding means such that a concatenation of

said multipart MIME message ... is transparent to the user. However, Hong et al disclose:

"...program then converts each new note into a formal HTML document.....which

encodes......MIME.......scheme is used......" (Col. 5, lines 2-11). It would have been obvious

to a person of ordinary skill in the art at the time of the invention to had combined the teachings

of Wolf and Hong et al *means such that a concatenation of said multipart MIME message ... is transparent to the user*, because Hong et al teach: ".....HTML documents.....are then concatenated into a single e-mail message......" (Col. 5, lines 5-9).

Claims 23-24 are directed towards a method for implementing the mail client found in claims 6-7 respectively, and are similarly rejected.

17.   Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolf, in view of Bradshaw, and further in view of Hong et al.

Regarding claim 17, which depends on claim 13, Wolf discloses the editing or decoding of the internet-compatible email document (c.2, L.8-67, c.9, L.1-c.10,L.67, and fig.3). Wolf fails fails to explicitly disclose: *said encoding means includes MIME-compatible encoding means.* However, Hong et al disclose: "program then converts each new note into a formal HTML document.....which encodes......MIME.......scheme is used......" (Col. 5, lines 2-11). It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings of Wolf, Bradshaw, and Hong et al, because Hong et al teach: ".....HTML documents.....are then concatenated into a single e-mail message......" (Col. 5, lines 5-9).

Regarding claim 18, which depends on claim 13, Wolf discloses the editing or decoding of the internet-compatible email document (c.2, L.8-67, c.9, L.1-c.10,L.67, and fig.3). Wolf fails to explicitly disclose: *said encoding means includes means for creating a MIME-compatible file.....* However, Hong et al disclose: "program then converts each new note into a formal HTML document.....which encodes......MIME.......scheme is used" (Col. 5, lines 2-11). It would have been obvious to a person of ordinary skill in the art at the time of the invention to

had combined the teachings of Wolf, Bradshaw, and Hong et al, because Hong et al teach:

"HTML documents.....are then concatenated into a single e-mail message" (Col. 5, lines 5-9).

Furthermore, Wolf discloses the editing or decoding of the internet-compatible email

document (c.2, L.8-67, c.9, L.1-c.10,L.67, and fig.3). Wolf fails to explicitly disclose: *each of*

said authoring component cooperating with said encoding means such that a creation of said

MIME file.....is transparent to the user. However, Hong et al disclose: "program then converts

each new note into a formal HTML document.....which encodes......MIME.......scheme is

used" (Col. 5, lines 2-11). It would have been obvious to a person of ordinary skill in the art at

the time of the invention to had combined the teachings of Fleming, Bradshaw, and Hong et al

such that a creation of said MIME file.....is transparent to the user, because Hong et al teach:

"HTML documents.....are then concatenated into a single e-mail message" (Col. 5, lines 5-9).

Regarding claim 19, which depends on claim 18, Wolf discloses the editing or decoding

of the internet-compatible email document (c.2, L.8-67, c.9, L.1-c.10,L.67, and fig.3). Wolf fails

to explicitly disclose: *said decoding means includes means for concatenating a multipart MIME*

message. However, Hong et al disclose: "HTML documents.....are then concatenated into a

single e-mail message" (Col. 5, lines 5-9). It would have been obvious to a person of ordinary

skill in the art at the time of the invention to have combined the teachings of Wolf, Bradshaw,

and Hong et al, because Hong et al teach: "HTML documents.....are then concatenated into a

single e-mail message" (Col. 5, lines 5-9).

Furthermore, Wolf discloses the editing or decoding of the internet-compatible email

document (c.2, L.8-67, c.9, L.1-c.10,L.67, and fig.3). Wolf fails to explicitly disclose: *each of*

said authoring component cooperating with said decoding means such that a concatenation of

said multipart MIME message ... is transparent to the user. However, Hong et al disclose:

"...program then converts each new note into a formal HTML document.....which

encodes......MIME.......scheme is used......" (Col. 5, lines 2-11). It would have been obvious

to a person of ordinary skill in the art at the time of the invention to have combined the teachings

of Wolf, Bradshaw, and Hong et al *means such that a concatenation of said multipart MIME*

message ... is transparent to the user, because Hong et al teach: "HTML documents.....are then

concatenated into a single e-mail message" (Col. 5, lines 5-9).

Response to Arguments

18.   Applicant's arguments with respect to claims 1-24, and 26-27 have been considered but

are moot in view of the new ground(s) of rejection. The Applicant indicates that the submitted

declaration from Baker, swearing behind the Fleming, removes the cited references from being

prior art (p.4,L.20-23). The Applicant are directed towards the newly crafted rejection of the

claims as outlined above.

Conclusion

I.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. Nguyen (Pat. # **6,377,978**).

II.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The

examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

> Director United States Patent and Trademark Office
>
> Washington, D.C. 20231

Or faxed to:

- **(703) 746-7238**, (for **After Final** communications intended for entry)

- **(703) 746-7239**, (for **Formal** communications intended for entry, **except formal After Final communications**)

   Or:

- **(703) 746-7240**, (for **Informal or Draft** communications for discussion only, please label "**PROPOSED**" or "**DRAFT**").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

CBP

10/29/02

STEPHEN S. HONG
PRIMARY EXAMINER